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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,964	01/16/2007	Florence Henry	C 2925 PCT/US	8591
23657	7590	02/07/2011	EXAMINER	
FOX ROTHSCHILD LLP 997 Lenox Drive, Bldg. #3 Lawrenceville, NJ 08648			TATE, CHRISTOPHER ROBIN	
			ART UNIT	PAPER NUMBER
			1655	
			NOTIFICATION DATE	DELIVERY MODE
			02/07/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,964	<b>Applicant(s)</b> HENRY ET AL.	
	<b>Examiner</b> Christopher R. Tate	<b>Art Unit</b> 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15,17-19,21,22,25,26 and 30-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15,17-19,21,22,25,26 and 30-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>0111</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The amendment filed 02 December 2010 is acknowledged and has been entered. Claims 15, 17, 18, 19, 21, 22, 25, 26, and 30-41 have been examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### **Claim Rejections - 35 USC § 103**

Claims 15, 17, 18, 19, 21, 22, 25, 26, and 30-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the International Cosmetic Ingredient Dictionary and Handbook (9th ed, 2002 - IDS reference) in view of the admitted state of the art, and further in view of Schneider (US 6,184,247), Chiej (MacDonald Encyclopedia of Medicinal Plants, 1984), and Brooks et al. (US 6,191,083), with evidence provided by Chevallier (Encycl. of Herbal Medicine, 2000)\*.

The cited International Cosmetic Ingredient Dictionary and Handbook beneficially teaches that Castanea sativa leaf extract is a well known herbal extract used in the cosmetic art as a skin-conditioning agent (see description of this plant extract on page 276 of this IDS reference). This document does not expressly teach the inclusion of auxiliaries or additives such as those instantly claimed therein. However, it should be noted that it is notoriously well recognized in the art that essentially all cosmetics comprise auxiliaries and/or additives such as many of those instantly claimed (e.g., thickeners, surfactants, emulsifiers, fats, waxes, antimicrobial agents, preservatives, perfumes, and/or dyes, etc.) therein - which Applicants readily admit are commonly used in the art for cosmetic purposes (see, e.g., page 6, 6th full paragraph, of the instant specification).

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Schneider beneficially teaches topical cosmetic compositions useful for treating skin (including for treating aging skin having wrinkles and/or age spots) which comprise, or may comprise, skin conditioners as well as one or more conventional cosmetic adjunct ingredients therein such as thickeners and/or plant extracts including witch hazel (in addition to one or more various auxiliaries and additives from among those instantly claimed - e.g. waxes, oils, emulsifiers, surfactants, perfumes, and/or preservatives) - see entire document including, e.g., col 1, lines 16-24; col 3, lines 31-49; col 4, lines 5-12; col 5, lines 29-35; col 6, lines 61-67; col 7, lines 6-64; col 8, lines 7-67; col 9, lines 9-21; col 10, Table 4, and col 11, Table 5.

Chiej beneficially teaches that *Castanea sativa* leaves have been used in the prior art as a substitute for witch hazel (see # 72 - herbal description of *Castanea sativa*) and teaches a cosmetic hair shampoo comprising an extract (e.g., in the form of an infusion or other fluid extract) of *Castanea sativa* leaves. As evidenced by Chevallier, infusions are prepared via placing the plant/herbal material in a strainer, then placing the strainer in hot/boiling water for 5-10 minutes, removing the strainer (with the plant/herbal material inside) to produce the extract infusion (see page 291 of Chevallier). Further, as evidenced by Chevallier, witch hazel is notoriously well known in the prior art to be used cosmetically to topically treat such ailments as skin abrasions, facial veins, varicose veins, and hemorrhoids, including in the form of a lotion or ointment (see page 104 of Chevallier).

As beneficially disclosed by Brooks et al. (and as notoriously well known in the cosmetic art), natural polysaccharides such as xanthan gum and guar gum are conventionally employed (and in the case of Brooks - preferably employed) as thickening agents in cosmetic compositions (including within cosmetic compositions containing a skin conditioning agent therein - within a

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preferred amount range of about 0.01% to about 3%, by weight: as also disclosed by Brooks et al.). See, e.g., col 9, lines 55-58; and col 16, lines 48-56.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include one or more auxiliaries and/or additives from among those instantly claimed (e.g., a conventional cosmetic thickener - as beneficially disclosed Schneider) including a notoriously well known natural polysaccharide thickener - such as xanthan gum or guar gum (as beneficially disclosed by Brooks) within a cosmetic composition comprising the well known cosmetic skin conditioning agent *Castanea sativa* leaf extract (as beneficially taught by the cited International Cosmetic Ingredient Dictionary and Handbook) therein, since such auxiliaries and/or additives are routinely incorporated within such cosmetic compositions and, as readily admitted by Applicants are well known in the art for such cosmetic purposes, as discussed above.

It would also have been obvious to one of ordinary skill in the art at the time the claimed invention was made to further include the well known cosmetic skin conditioning agent *Castanea sativa* leaf extract (as beneficially taught by the cited International Cosmetic Ingredient Dictionary and Handbook) - prepared via the instantly claimed steps, within a topical cosmetic composition such as taught Schneider because Schneider beneficially discloses that skin conditioners as well as one or more conventional cosmetic adjunct ingredients such as thickeners (as noted above, xanthan gum or guar gum are notoriously well known conventional polysaccharide thickener within such cosmetics - as beneficially disclosed by Brooks, making their inclusion clearly obvious therein) and/or plant extracts including witch hazel may be included therein, and because Chiej beneficially teaches that *Castanea sativa* leaves (which

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Chiej also beneficially teaches can be effectively extracted via conventional infusion/fluid extraction thereof) have been used in the prior art as a substitute for witch hazel, making the incorporation of such a *Castanea sativa* leaf extract an obvious equivalent substitution for the witch hazel extract disclosed by Schneider therein. If not expressly taught, please note that the instantly claimed functional effects (anti-ageing and/or other recited skin effects such as those recited in instant claims 18 and 19) would be intrinsic upon topical application to the skin and/or scalp of a cosmetically-treated subject. The adjustment of particular conventional working conditions (e.g., determining an appropriate amount of an infused *Castanea sativa* leaf extract to incorporate therein, including water as a commonly-employed carrier/diluent therein, and/or using a conventional extraction solvent such as water or ethanol to prepare such a *Castanea sativa* leaf extract as well as removing the solvent therefrom following extraction so as to form a concentrated extract) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

\* Please note that the Chevallier reference is not being cited as art within the USC 103 rejection above, but instead is being cited to show an inherent feature with respect to preparing a plant infusion (e.g., from *Castanea sativa* leaves) such as reasonably taught/suggested by the Chiej reference, as well as to show the well known prior art cosmetic uses of witch hazel (as discussed within the USC 103 rejection above).

With respect to new claims 34-41 - which are drawn to a method for cosmetic treatment via topically applying a composition consisting of a *Castanea sativa* leaf extract and one or more thickeners, please note that the omission of one or more elements (including the omission of one or more conventional cosmetic auxiliaries/additives other than thickeners therefrom) and its function is considered obvious if the function is not desired or required (see, e.g., MPEP 2144.04). In other words, it would have been obvious in the cosmetic art to provide a simple cosmetic composition consisting of a *Castanea sativa* leaf extract (such as beneficially disclosed by the cited International Cosmetic Ingredient Dictionary and Handbook and/or by Chiej) and one or more well known cosmetic thickeners (including one or more conventionally employed natural polysaccharides such as xanthan gum and/or guar gum) as the singular cosmetic base ingredient therein - as well as to topically apply such a cosmetic composition to the skin of a human (as instantly claimed).

Applicants' arguments as they pertain to the USC 103 rejection above have been carefully considered but are not deemed to be persuasive of error in the rejection. Applicants argues that the International Cosmetic Ingredient Dictionary and Handbook teaches that an extract of the leaves of *Castanea sativa* has a skin-conditioning function, but does not teach it has an anti-ageing effect. However, for the reasons fully set forth above, such a functional effect would be intrinsic upon topical application to human skin and/or scalp of a cosmetic composition comprising/consisting of *Castanea sativa* leaf extract and one or more auxiliaries/additions (such as a polysaccharide thickener) - including under two scenarios: firstly, cosmetically treating human skin in a prophylactic manner; secondly, since the skin of all humans continues to age

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due to constant environment exposures as well as the natural skin aging process from birth through old age, the recited anti-ageing functional effect would be intrinsic upon such topical application to the human's skin). Applicants further argue that some of the claims are drawn to the at least one auxiliary and/or additive being a thickener, preferably a polysaccharide; as well as applying a composition consisting of an extract of *Castanea sativa* leaves, one or more thickeners (preferably a polysaccharide) and, in some cases, water. However, these arguments have been addressed within the USC 103 rejection above - including, as noted immediately above with respect to limitations recited by new claims 34-41.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



### **Conclusion**

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher R. Tate/  
Primary Examiner, Art Unit 1655